

First, applicants respectfully assert that the office action has misapplied a legal precedent to support an obviousness rejection. The office action states in paragraph 7 that it would have been obvious to one of ordinary skill in the art to at the time the invention was made to incorporate the teachings of Shimizu into the Lin reference. To support this conclusion, the office action goes on to paraphrase the legal decision in the case of *In re Stevens*, 101 USPQ 284 (CCPA 1954) by stating that “[w]here the general conditions of a claim are disclosed in prior art, provision of adjustability where needed involves only routine skill in the art.”

Applicants respectfully point out that prior legal precedent may serve as a source of supporting rationale if the facts of the legal decision are sufficiently similar to those in an application under examination. (See MPEP 2144.04) However, in this case, applicants respectfully assert that the legal decision of *In re Stevens* may not serve as a source of supporting rationale for an obviousness rejection for the following reasons.

The facts of the current application under examination are not sufficiently similar to the facts in the legal decision of *In re Stevens*. In *Stevens*, the claims were directed to a handle for a fishing rod wherein the handle has a longitudinally adjustable finger hook, and the hand grip of the handle connects with the body portion by means of a universal joint. The court held that adjustability, where needed, is not a patentable advance, and because there was an art-recognized need for adjustment in a fishing rod, the substitution of a universal joint for the single pivot of the prior art would have been obvious. In contrast, the claimed invention is directed to subject matter related to a method of semiconductor processing where “adjustability” is not relevant. That is, the applicants assert that it would not have been obvious to combine the teaching of Shimizu into the Lin because the claimed invention is not directed to the mechanical arts or analogous to replacing a fixed element with an adjustable element – nor is there a suggestion to replace a fixed element with an adjustable element.

In addition, applicants assert that it would not have been obvious to combine the teaching of Lin and Shimizu to arrive at the claimed invention for the following reasons. The Shimizu removes the oxidation resistant film 301 and the thin oxide 201 while the photoresist film 402 is still disposed on the first device formation area (Fig. 2E). Thus, assuming *arguendo* that a

person of ordinary skill in the art would combine the teachings of Lin and Shimizu, what he would have been taught is to place another photoresist layer on the second active region 22 of Lin, and then remove the first gate oxide layer 23 from the first active region 21. Then, he would have been taught to remove the photoresist layer from the second active region 22 and supplant an oxide layer over the first and second active regions by oxidation. Thus, a person of ordinary skill in the art would not have been taught to remove the oxide layer on the second formation area along with the oxidation resistant film on the second formation region, and forming a new oxidation by thermal oxidation without the additional step of forming another photoresist layer. In the present invention, this additional photoresist layer is not needed. Claims 1 and 4 make this difference clear by reciting "without forming a photoresist."

Moreover, the teachings of Lin actually teach away from the desirability of applying the teaching of Shimizu. For example, once the resulting configuration as illustrated in FIG. 2D of Lin is produced, "subsequent processing for forming gate electrodes and source/drain regions are identical to the conventional method." (See column 3, lines 57-59) FIG. 2D shows a semiconductor component that has two active regions 21,22 and two respective oxide layers of different thickness 23, 26. The semiconductor process for oxide layer processing is complete. Clearly, one skilled in the art would only be motivated to subsequently form gate electrodes and source/drain regions using conventional methods and **not** be motivated to apply the additional processing steps from the Shimizu reference as suggested by the office action.

In view of the above, applicants respectfully request withdrawal and allowance of the application.

It is believed that no fee is due. However, if a fee or a refund is due, please apply any charges or credits to deposit account 06-1050.

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